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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/210,952 12/15/98 FAINZILDER

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EXAMINER

LEE, L

ART UNIT

PAPER NUMBER

1645

10

DATE MAILED:

03/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/210,952

Applicant(s)

Fainzilber et al

Examiner

Li Lee

Group Art Unit

1645



☒ Responsive to communication(s) filed on Dec 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-10 and 12-47 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-10 and 12-47 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group I, claims 1-36 in Paper No. 9 is acknowledged.

Applicant's amendment filed on Dec 06, 1999 (Paper Number 9) has been received and entered. Claim 11 has been canceled, claims 1, 3-7, 10, 12-19 have been amended, consequently claims 1-10 and 12-47 are pending in the instant application.

However, upon further consideration, restriction to one of the following inventions under 35 U.S.C. 121 is required:

- I. Claims 1-6, drawn to a conopeptide having the general formula I (SEQ ID NO:1), classified in class 530, subclass 300.
- II. Claims 7-10, 12-13, drawn to a conopeptide having the general formula II (SEQ ID NO:2), classified in class 530, subclass 300.
- III. Claims 14-15, drawn to a conopeptide having the general formula III (SEQ ID NO:3), classified in class 530, subclass 300.
- IV. Claims 16-17, drawn to a conopeptide having the general formula IV (SEQ ID NO:4), classified in class 530, subclass 300.
- V. Claims 18-19, drawn to a conopeptide having the general formula V (SEQ ID NO:5), classified in class 530, subclass 300.

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- VI. Claims 20-26, 27, drawn to a conopeptide, PnVIIA (SEQ ID NO:6), classified in class 530, subclass 300.
- VII. Claims 20-26, 28, drawn to a conopeptide, Tx6.4 (SEQ ID NO:7), classified in class 530, subclass 300.
- VIII. Claims 20-26, 29, drawn to a conopeptide, Tx6.9 (SEQ ID NO:8), classified in class 530, subclass 300.
- IX. Claims 20-26, 32, drawn to a conopeptide, J010 (SEQ ID NO:9), classified in class 530, subclass 300.
- X. Claims 20-26, 30, drawn to a conopeptide, Tx6.6 (SEQ ID NO:10), classified in class 530, subclass 300.
- XI. Claims 20-26, 31, drawn to a conopeptide, Tx6.5 (SEQ ID NO:11), classified in class 530, subclass 300.
- XII. Claims 20-26, 33, drawn to a conopeptide, Gm6.7 (SEQ ID NO:12), classified in class 530, subclass 300.
- XIII. Claims 20-26, 34, drawn to a conopeptide, Mr6.1 (SEQ ID NO:13), classified in class 530, subclass 300.
- XIV. Claims 20-26, 35, drawn to a conopeptide, Mr6.2 (SEQ ID NO:14), classified in class 530, subclass 300.
- XV. Claims 20-26, 36, drawn to a conopeptide, Mr6.3 (SEQ ID NO:15), classified in class 530, subclass 300.

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- XVI. Claims 37, 38, drawn to isolated nucleic acid encoding a Tx 6.4 propetide, classified in class 536, subclass 23.1.
- XVII. Claims 37, 39, drawn to isolated nucleic acid encoding a Tx 6.9 propetide, classified in class 536, subclass 23.1.
- XVIII. Claims 37, 40, drawn to isolated nucleic acid encoding a J010 (not J0104) propetide, classified in class 536, subclass 23.1.
- XIX. Claims 37, 41, drawn to isolated nucleic acid encoding a Tx 6.6 propetide, classified in class 536, subclass 23.1.
- XX. Claims 37, 42, drawn to isolated nucleic acid encoding a Tx 6.5 propetide, classified in class 536, subclass 23.1.
- XXI. Claims 37, 43, drawn to isolated nucleic acid encoding a Gm6.7 propetide, classified in class 536, subclass 23.1.
- XXII. Claims 37, 44, drawn to isolated nucleic acid encoding a Mr6.1 propetide, classified in class 536, subclass 23.1.
- XXIII. Claims 37, 45, drawn to isolated nucleic acid encoding a Mr6.2 propetide, classified in class 536, subclass 23.1.
- XXIV. Claims 37, 46, drawn to isolated nucleic acid encoding a Mr6.3 propetide, classified in class 536, subclass 23.1.
- XXV. Claims 37, 47, drawn to isolated nucleic acid encoding a Tx 6.1 propetide, classified in class 536, subclass 23.1.

2. The inventions are distinct, each from the other because of the following reasons:

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The Groups I - XXV are related as products. The claims of Groups I - XV are drawn to a conopeptides which have different peptide formulas and are structurally and physically different protein peptides. Those of Group XVI- XXV are drawn to isolated polynucleotides which encode structurally and physically different conopeptides. The inventions of Groups I - XXV can be shown to be distinct because they are made by different methods (e.g., in vitro chemical synthesis versus recombinant production) and because they are physically (e.g., amino acids versus nucleic acid) and functionally (e.g., mediate biological activity versus encode proteins) distinct chemical entities.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by the different classification, and absent restriction would place an undue search and examination burden on the examiner, therefore restriction for examination purposes as indicated is proper.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995.

Li Lee  
March 24, 2000

  
ALBERT NAVARRO  
PATENT EXAMINER